



## **LOCAL PATENT RULES**

Effective: December 1, 2009

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

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## **LOCAL PATENT RULES**

### **1. SCOPE OF RULES**

#### **LPR 1.1      AUTHORITY**

The Local Patent Rules for the United States District Court for the Western District of Pennsylvania are promulgated as authorized by and subject to the limitations of Federal Rule of Civil Procedure 83.

#### **LPR 1.2      CITATION**

These are the Local Rules of Practice for Patent Cases before the United States District Court for the Western District of Pennsylvania. They should be cited as "LPR," followed by the applicable rule number and subsection.

#### **LPR 1.3      APPLICATION AND CONSTRUCTION**

These rules apply to all civil actions filed in or transferred to this Court which allege infringement of a utility patent in a complaint, counterclaim, cross-claim or third party claim, or which seek a declaratory judgment that a utility patent is not infringed, is invalid or is unenforceable. The Court may accelerate, extend, eliminate, or modify the obligations or deadlines set forth in these Local Patent Rules based on the circumstances of any particular case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved. If any motion filed prior to the Claim Construction Hearing provided for in LPR 4.4 raises claim construction issues, the Court may, for good cause shown, defer the motion until after completion of the disclosures, filings, or ruling following the Claim Construction Hearing. The Local Civil Rules of this Court shall also apply to these actions, except to the extent that they are inconsistent with these Local Patent Rules.

#### **LPR 1.4      EFFECTIVE DATE**

These Local Patent Rules shall take effect on April 1, 2005 and shall apply to any case filed thereafter. The parties to any other pending civil action in which the infringement, validity or enforceability of a utility patent is an issue shall meet and confer promptly after April 1, 2005, for the purpose of determining whether any provisions in these Local Patent Rules should be made applicable to that case. No later than seven (7) calendar days after the parties meet and confer, the parties shall file a stipulation setting forth a proposed order that relates to the application of these Local Patent Rules. Unless and until an order is entered applying these Local Patent Rules to any pending case, the Local Civil Rules previously applicable to pending patent cases shall govern.

## **LPR 1.5      ALTERNATIVE DISPUTE RESOLUTION**

Unless the Court orders otherwise, the default form of alternative dispute resolution in any case governed by these Local Patent Rules shall be Early Neutral Evaluation, which shall occur in accordance with the procedures stated in the ADR Policies and Procedures, as adopted by the Board of Judges for the United States District Court for the Western District of Pennsylvania. However, if all parties (1) mutually agree to employ some other form of alternative dispute resolution, such as Mediation or Arbitration, and (2) mutually agree to the timing therefor, then, unless the Court orders otherwise, the deadline for completing such Mediation or Arbitration shall be 60 calendar days after the Court's decision on claim construction.

## **2. GENERAL PROVISIONS**

### **LPR 2.1      GOVERNING PROCEDURE**

**Initial Scheduling Conference.** When the parties confer with each other pursuant to Fed. R. Civ. P. 26(f), in addition to the matters covered by Fed. R. Civ. P. 26, the parties must discuss and address in the statement filed pursuant to Fed. R. Civ. P. 26(f), the following topics:

Proposed modification of the deadlines provided for in these Local Patent Rules and/or set forth in the Court's Scheduling Order (see Model Scheduling Order at "Appendix LPR 2.1" for types of deadlines that might be included) and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;

The joint nomination of a special master to be appointed in the case for purposes of claim construction, based upon mutual agreement of the parties;

Whether the Court will hear live testimony at the Claim Construction Hearing;

The need for and any specific procedures or limits on discovery relating to claim construction, including depositions of witnesses, including expert witnesses;

The order of presentation at the Claim Construction Hearing;

Whether parties are willing to go to trial in front of a Magistrate Judge; and

The form(s) of alternative dispute resolution (Early Neutral Evaluation, Arbitration, or Mediation) that will be utilized in the case, along with the following information:

- the joint nomination of the neutral(s) to be appointed by the Court for purposes of alternative dispute resolution, based upon mutual agreement of the parties;
- percentage of payment responsibility by each party for any fees and expenses associated with the neutral(s);
- the date(s) on which the selected form of alternative dispute resolution will occur; and
- identification of each party representative(s) who will attend the selected alternative dispute resolution session(s).

**Further Scheduling Conferences.** To the extent that some or all of the matters provided for in LPR 2.1 are not resolved or decided at the Initial Scheduling Conference, the parties shall propose dates for further Scheduling Conferences at which such matters shall be decided.

## **LPR 2.2      CONFIDENTIALITY**

All documents or information produced under these Local Patent Rules shall be governed by the terms and conditions of the Protective Order in "Appendix LPR 2.2." Such Protective Order shall be deemed automatically entered upon the filing or transfer of any civil action to which these Local Patent Rules apply pursuant to LPR 1.3, unless otherwise modified by agreement of the parties or Order of Court.

## **LPR 2.3      CERTIFICATION OF INITIAL DISCLOSURES**

All statements, disclosures, or charts filed or served in accordance with these Local Patent Rules must be dated and signed by counsel of record (or by the party if unrepresented by counsel). Pursuant to Rules 11 and 26(g) of the Federal Rules of Civil Procedure, counsel's signature (or the signature of the unrepresented party) shall constitute a certification that to the best of his or her knowledge, information, and belief, formed after an inquiry that is reasonable under the circumstances, the information contained in the statement, disclosure, or chart is complete and correct at the time it is made.

## **LPR 2.4      ADMISSIBILITY OF DISCLOSURES**

Except as hereinafter provided, statements, disclosures, or charts governed by these Local Patent Rules are admissible to the extent permitted by the Federal Rules of Evidence or Procedure. However, the statements or disclosures provided for in LPR 4.1 and 4.2 are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by these Local Patent Rules must be taken.

## **LPR 2.5      RELATIONSHIP TO FEDERAL RULES OF CIVIL PROCEDURE**

Except as provided in this paragraph or as otherwise ordered, it shall not be a legitimate ground for objecting to an opposing party's discovery request (e.g., interrogatory, document request, request for admission, deposition question) or declining to provide information otherwise required to be disclosed pursuant to Fed. R. Civ. P. 26(a)(1) that the discovery request or disclosure requirement is premature in light of or otherwise conflicts with, these Local Patent Rules. A party may object, however, to the following categories of discovery requests (or decline to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) on the ground that they are premature in light of the timetable provided in the Local Patent Rules:

Requests seeking to elicit a party's claim construction position;

Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality; and

Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art.

Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to provide the requested information to an opposing party under these Local Patent Rules, unless there exists another legitimate ground for objection.

The parties are reminded that the obligations under Fed. R. Civ. P. 26(e) to supplement disclosure and discovery responses shall apply to all Patent Initial Disclosures and all other discovery responses associated with these Local Patent Rules.

### **3. PATENT INITIAL DISCLOSURES**

#### **LPR 3.1 INITIAL DISCLOSURES**

Not later than fourteen (14) days before the Initial Scheduling Conference, the parties shall exchange the initial disclosures required by Fed. R. Civ. P. 26(a)(1) ("Initial Disclosures").

With the Initial Disclosures of the party asserting a claim of patent infringement, such party shall produce or make available for inspection and copying, among other items:

All Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreement, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell or other manner of transfer, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;

All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or a priority date otherwise identified for the patent in suit, whichever is earlier; and

All documents evidencing communications to and from the U.S. Patent Office for each patent in suit and for each patent on which a claim for priority is based.

The producing party shall separately identify by production number which documents correspond to each category.

With the Initial Disclosures of the party opposing a claim of patent infringement, such party shall produce or make available for inspection and copying, among other items:

Source code, specifications, schematics, flow charts, artwork, formulas, drawings or other documentation, including sales literature, sufficient to show the operation of any aspects or elements of each accused apparatus, product, device, process, method or other instrumentality identified in the claims pled of the party asserting patent infringement; and

A copy of each item of prior art, of which the opposing party is aware, that allegedly anticipates each asserted patent and its related claims or renders them obvious.

### **LPR 3.2      DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS**

Not later than thirty (30) calendar days after the Initial Scheduling Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Infringement Contentions." Separately for each opposing party, the "Disclosure of Asserted Claims and Infringement Contentions" shall contain the following information:

Each claim of each patent in suit that is allegedly infringed by each opposing party;

Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party claiming infringement is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality, and if present under the doctrine of equivalents, the asserting party shall also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial;

For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

### **LPR 3.3      DOCUMENT PRODUCTION ACCOMPANYING DISCLOSURE**

With the "Disclosure of Asserted Claims and Infringement Contentions," the party claiming patent infringement shall supplement its Initial Disclosures, if applicable, based upon the Initial Disclosures of the opposing party.

### **LPR 3.4      NON-INFRINGEMENT AND/OR INVALIDITY CONTENTIONS**

Not later than fourteen (14) days after service upon it of the "Disclosure of Asserted Claims and Infringement Contentions," each party asserting non-infringement and/or invalidity of a patent, shall serve upon all parties its "Non-infringement and/or Invalidity Contentions." Non-infringement Contentions shall contain a chart, responsive to the chart required by LPR 3.2, that states as to each identified element in each asserted claim, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality, and, if not, the reason for such denial and the relevant distinctions. Invalidity Contentions must contain the following information:

The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing --

The name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

Whether each item of prior art allegedly anticipates each asserted claim or renders it obvious. If a combination of items of prior art allegedly makes a claim obvious, each such combination, and the motivation to combine such items, must be identified;

A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and

Any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims.

### **LPR 3.5      DOCUMENT PRODUCTION ACCOMPANYING INVALIDITY CONTENTIONS**

With the "Non-infringement and/or Invalidity Contentions," the party asserting non-infringement and/or invalidity of a patent shall supplement its Initial Disclosures and, in particular, must produce or make available for inspection and copying:

Any additional documentation showing the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its LPR 3.2 chart; and



A copy of any additional items of prior art identified pursuant to LPR 3.4 which does not appear in the file history of the patent(s) at issue.

### **LPR 3.6          DISCLOSURE REQUIREMENT IN PATENT CASES INITIATED BY DECLARATORY JUDGMENT**

**Non-infringement and/or Invalidity Contentions If No Claim of Infringement.** In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 3.2 and 3.3 shall not apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in its answer to the complaint, no later than thirty (30) calendar days after the Initial Scheduling Conference, the party seeking a declaratory judgment must serve upon each opposing party its Non-infringement and/or Invalidity Contentions that conform to LPR 3.4 and produce or make available for inspection and copying the documentation described in LPR 3.5.

**Application of Rules When No Specified Triggering Event.** If the filings or actions in a case do not trigger the application of these Local Patent Rules under the terms set forth herein, the parties shall, as soon as such circumstances become known, meet and confer for the purpose of agreeing on the application of these Local Patent Rules to the case.

**Inapplicability of Rule.** This LPR 3.6 shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable is filed in response to a complaint for infringement of the same patent.

### **LPR 3.7          AMENDMENT TO CONTENTIONS**

Amendments or modifications of the Infringement Contentions or the Non-infringement and/or Invalidity Contentions are permissible, subject to other applicable rules of procedure and disclosure requirements, if made in a timely fashion and asserted in good faith and without purpose of delay. The Court's ruling on claim construction may support a timely amendment or modification of the Infringement Contentions or the Non-infringement and/or Invalidity Contentions.

## **4. CLAIM CONSTRUCTION PROCEEDINGS**

### **LPR 4.1          EXCHANGE OF PROPOSED CLAIM TERMS AND PHRASES FOR CONSTRUCTION**

Not later than fourteen (14) days after: (i) service of the Non-infringement and/or Invalidity Contentions pursuant to LPR 3.4; or (ii) an agreement of the parties to expedite claim construction following the Initial Scheduling Conference pursuant to LPR 2.1, each party shall simultaneously exchange a list of claim terms and phrases which that party contends should be construed by the Court, and identify any claim element which that party contends should be governed by 35 U.S.C. § 112(6).

#### **LPR 4.2      PREPARATION AND FILING OF JOINT DISPUTED CLAIM TERMS CHART**

Not later than fourteen (14) days after the exchange set forth in LPR 4.1, the parties shall meet and confer to identify claim terms and phrases that are in dispute, and claim terms and phrases that are not in dispute, and shall prepare and file a Joint Disputed Claim Terms Chart listing claim terms and phrases and corresponding intrinsic evidence for each disputed claim term and phrase, asserted by each party. The Joint Disputed Claim Terms Chart shall be in the format shown in "Appendix LPR 4.2." Each party shall also file with the Joint Disputed Claim Terms Chart an appendix containing a copy of each exhibit of intrinsic evidence cited by the party in the Joint Disputed Claim Terms Chart.

#### **LPR 4.3      CLAIM CONSTRUCTION BRIEFING AND EXTRINSIC EVIDENCE**

Not later than thirty (30) calendar days after filing of the Joint Disputed Claim Terms Chart pursuant to LPR 4.2, the Plaintiff (including the Plaintiff alleging non-infringement in a declaratory judgment action), unless otherwise stipulated by the parties, shall serve and file an Opening Claim Construction Brief including a proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Such Opening Claim Construction Brief shall also, for each element which the party contends is governed by 35 U.S.C. § 112(6), describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. Such Opening Claim Construction Brief shall further include a statement of the anticipated length of time necessary for the party to present its case at the claim construction hearing. For purposes of this rule, if there is no claim of patent infringement present in the complaint as originally filed, then the party first alleging infringement or non-infringement of the subject patent shall serve and file the Opening Claim Construction Brief.

At the same time the party serves its Opening Claim Construction Brief, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es).

Not later than twenty-one (21) days after service of the Opening Claim Construction Brief, the opposing party shall serve and file a Response to Opening Claim Construction Brief including the party's proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Such Response shall also, for each element which the opposing party contends is governed by 35 U.S.C. § 112(6), describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. Such Response shall further include a statement of the anticipated length of time necessary for the party to present its case at the Claim Construction Hearing and a concise statement not to exceed five (5) pages as to whether the party objects to the opening party's offer of extrinsic evidence.

At the same time the opposing party serves its Response, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced.

With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es).

Not later than fourteen (14) days after service of the Response, the opening party may serve and file a Reply directly rebutting the opposing party's Response. Such Reply shall further include a concise statement not to exceed five (5) pages as to whether the party objects to the opposing party's offer of extrinsic evidence.

In the event that the party bearing the burden of proof on the issue of infringement is the party filing the Response, that party may file a Surreply directly rebutting the opposing party's Reply without leave of Court. Such Surreply shall be filed no later than fourteen (14) days after the service of the Reply and shall not exceed five (5) pages.

Prior to the Claim Construction Hearing, the Court may issue an order stating whether it will receive extrinsic evidence and, if so, the particular evidence that it will exclude and that it will receive, and any other matter the Court deems appropriate concerning the conduct of the hearing.

#### **LPR 4.4 CLAIM CONSTRUCTION HEARING**

Subject to the convenience of the Court's calendar, fourteen (14) days following submission of the Reply specified in LPR 4.3, the Court shall conduct a Claim Construction Hearing.

#### **LPR 4.5 SPECIAL MASTER REPORT AND RECOMMENDATION ON CLAIM CONSTRUCTION**

If a Special Master for the purpose of claim construction is appointed, the Special Master shall be empowered to hold hearings and receive and report evidence on the issue of claim construction.

Within 30 calendar days following the hearing on the issue of claim construction, the Special Master shall submit to the Court a report and recommendation on the issue of claim construction. Either party may file objections to -- or a motion to adopt or modify -- the Special Master's report and recommendation, no later than fourteen (14) days from the time the Special Master's report and recommendations are submitted. A party may file a response to such objection or motion within fourteen (14) days of the initial filing of such objection or motion.

The compensation to be paid to the Special Master shall be fixed and determined by the Court pursuant to Federal Rule of Civil Procedure 53(a). Unless otherwise ordered by the Court, the parties shall equally split the costs and fees for services rendered by the Special Master.

## **5. EXPERT WITNESSES**

### **LPR 5.1 DISCLOSURE OF EXPERTS AND EXPERT REPORTS**

For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule.

No later than thirty (30) calendar days after the court's ruling on claim construction, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which each bears the burden of proof.

No later than thirty (30) calendar days after the first round of disclosures, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which the opposing party bears the burden of proof.

Unless otherwise ordered by the Court, no later than fourteen (14) days after the second round of disclosures, each party shall make any rebuttal expert witness disclosures permitted by Rule 26.

### **LPR 5.2 DEPOSITIONS OF EXPERTS**

Depositions of expert witnesses disclosed under this Rule, if any, shall commence within seven (7) calendar days after rebuttal reports are served and shall be completed within thirty (30) calendar days after commencement of the deposition period.